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10/620,254	07/15/2003	Joseph H. Matthews III	MS1-093USC2	9753

22801 7590 10/31/2007	**EXAMINER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Specification

1.   The abstract of the disclosure is objected to because the length of 294 words

exceeds the maximum of 150. Correction is required. See MPEP § 608.01(b).

2.   The disclosure is objected to because it contains an embedded hyperlink and/or

other form of browser-executable code. Applicant is required to delete the embedded

hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

3.   The disclosure is objected to because on Page 15 the application referred to

Element 74 (Network # 1) as Element 72 (a computer mouse). Appropriate correction is

required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

4.   Claims 49-53 are rejected under 35 U.S.C. 101 because the claimed invention is

not supported by either a process, machines, manufactures and composition of matter

asserted utility or a well established utility.

For **Claim 49** Application claims "A computer-readable medium comprising

computer-executable instructions." However, Claim 49 does not define a _computer-readable medium_ to be a memory/disk, see Application's specification, and is thus non-statutory for that reason. Application's specification does not exclude "a computer-readable medium" from other forms of propagated signals that computer program product may be formatted. Therefore, the full scope of Claim 49 as properly read in light of the disclosure encompasses non-statutory subject matter, i.e. signal, the claim as a whole is non-statutory under present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the **Claim 49** to include the disclosed tangible computer readable media while at the same time excluding the phrase "A computer-readable medium _comprising_ computer-executable instructions". The Examiner suggests the phrase "A computer-readable medium _encoded with_ computer-executable instructions".

For **Claim 50**, Application claims "A computer readable medium as recited in claim 49", and is therefore non-statutory as discussed in independent Claim 49.

For **Claim 51**, Application claims "A computer readable medium as recited in claim 50", and is therefore non-statutory as discussed in Claim 50 and independent Claim 49.

For **Claim 52**, Application claims "A computer readable medium as recited in claim 49", and is therefore non-statutory as discussed in independent Claim 49.

For **Claim 53**, Application claims "A computer readable medium as recited in claim 49", and is therefore non-statutory as discussed in independent Claim 49.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.   Claims **47**, **48** and **54** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 and 2 of U.S. Patent No. 6,631,523.

Application **Claim 47** with additional limitations, i.e. ("correlating URLs with particular programs in the EPG" and "target resources that contain supplemental information related to the particular programs" and "particular programs" and finally "URLs as interactive programs") claims all limitations of Patent 6,631,523 Claim 1.

Application **Claim 47** and Patent 6,631,523 Claim 1 are both drawn to the same

invention, i.e. "a user interface having an EPG application". Although the conflicting

claims are not identical, they are not patentably distinct from each other because both

Application **Claim 47** and Claim 1 of Patent 6,631,523 are almost the same in scope,

although Claim 1 of Patent 6,631,523 omits some limitations in Application **Claim 47**.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Claim 1 of Patent 6,631,523 with those additional

limitations so to obtain Application **Claim 47** as claimed.

Allowance of Application **Claim 47** would result in an unjustified time-wise

extension of the monopoly granted for the invention defined by Claim 1 of Patent

6,631,523. Therefore obviousness-type double patenting is appropriate.

Application **Claim 48** with the additional limitations, "a visual display"

and "the processor being programmed to compile a list of the interactive programs and

present the list of interactive programs on the visual display" corresponds to Patent

6,631,523 Claim 1, because it is inherent to have a display so as to be able to view the

EPG.

Application **Claim 54** with additional limitations, i.e. ("correlating hyperlinks with

corresponding programming information" and "searching the EPG to identify interactive

programs within the programming information that have correlated hyperlinks") claims

all limitations of Patent 6,631,523 Claim 2.

Application **Claim 54** and Patent 6,631,523 Claim 2 are both drawn to the same

invention, i.e. "a system having an electronic program guide". Although the conflicting

claims are not identical, they are not patentably distinct from each other because both

Application **Claim 54** and Claim 2 of Patent 6,631,523 are almost the same in scope,

although Claim 2 of Patent 6,631,523 omits some limitations in Application **Claim 54**.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Claim 2 of Patent 6,631,523 with those additional

limitations so as to obtain Application **Claim 54** as claimed.

Allowance of Application **Claim 54** would result in an unjustified time-wise

extension of the monopoly granted for the invention defined by Claim 2 of Patent

6,631,523. Therefore obviousness-type double patenting is appropriate.

6.   **Claims 47-49** and **52-54** are rejected on the ground of nonstatutory obviousness-

type double patenting as being unpatentable over Claims 1, 2, and 8 of U.S. Patent No.

6,025,837.

Application **Claim 47** with additional limitations, i.e. ("A user interface unit" and "a

processor" and "EPG executing on the processor" and "particular programs" and "target

resources that contain supplemental content related to particular programs" and finally

"the processor being programmed to search the EPG and identify particular programs

having URLs as interactive programs") claims limitations of Patent 6,025,837 Claim 8.

Application **Claim 47** and Patent 6,025,837 Claim 8 are both drawn to the same

invention, i.e. "a user interface system having an electronic program guide" Although the

conflicting claims are not identical, they are not patentably distinct from each other

because both Application **Claim 47** and Claim 8 of Patent 6,025,837 are almost the

same in scope, although Claim 8 of Patent 6,025,837 omits some limitations in

Application **Claim 47**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Claim 8 of Patent 6,025,837 with those additional limitations so to obtain Application **Claim 47** as claimed.

Allowance of Application **Claim 47** would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Claim 8 of Patent 6,025,837. Therefore obviousness-type double patenting is appropriate.

Application **Claim 48** with the additional limitations, "a visual display" and "the processor being programmed to compile a list of the interactive programs and present the list of interactive programs on the visual display" corresponds to Patent 6,025,837 Claim 8, because it is inherent to have a display so as to be able to view the EPG.

Application **Claim 49** with additional limitations, i.e. ("A computer-readable medium comprising computer-executable instructions" and "designating data fields in an electronic programming guide (EPG) to hold programming information" and "dedicating one of the data fields as a supplemental content field" and "entering a target specification into the supplemental content field to correlate supplemental content with a program, the target specification identifying a location for the supplemental content" and "compiling a list of interactive programs, wherein each interactive program in the list is a program having an associated target specification and finally "presenting the list of interactive programs through an EPG user interface supported by the EPG") claims limitations of Patent 6,025,837 Claims 1 and 2.

Application **Claim 49** and Patent 6,025,837 Claims 1, 2 are both drawn to the same invention i.e., "an EPG that correlates additional information with programs" even though Application **Claim 49** describes a computer-readable medium and Patent 6,025,837 Claims 1-2 describes a system. . Although the conflicting claims are not identical, they are not patentably distinct from each other because both Application **Claim 49** and Claims 1 and 2 of Patent 6,025.837 are almost the same in scope, although Claim 1 and 2 of Patent 6,025,837 omits some limitations in Application **Claim 49**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Claims 1 and 2 of Patent 6,025,837 with those additional limitations so to obtain Application **Claim 49** as claimed.

Allowance of Application **Claim 49** would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Claims 1 and 2 of Patent 6,025,837. Therefore obviousness-type double patenting is appropriate.

Application **Claim 52** corresponds to Patent 6,025,837 Claims 1 and 2.

Application **Claim 53** corresponds to Patent 6,025,837 Claims 1 and 2.

Application **Claim 54** with the additional limitation, "searching the EPG to identify interactive programs within the programming information that have correlated hyperlinks" claims limitations of Patent 6,025,837 Claim 8.

Application **Claim 54** and Patent 6,025,837 Claim 8 are both drawn to the same invention, i.e., "a system having an electronic program guide". Although the conflicting claims are not identical, they are not patentably distinct from each other because both Application **Claim 54** and Claim 8 of Patent 6,025,837 are almost the same in scope,

although Claim 8 of Patent 6,025,837 omits some limitations in Application **Claim 54**.
Therefore, it would have been obvious to one of ordinary skill in the art at the time the
invention was made to modify Claim 8 of Patent 6,025,837 with those additional
limitations so to obtain Application **Claim 54** as claimed.

Allowance of Application **Claim 54** would result in an unjustified time-wise
extension of the monopoly granted for the invention defined by Claim 8 of Patent
6,025,837. Therefore obviousness-type double patenting is appropriate.

7.   Claims **47, 48** and **54** are rejected on the ground of nonstatutory obviousness-
type double patenting as being unpatentable over Claims 1-4 of U.S. Patent 6,240,555.

Application **Claim 47** and Patent 6,240,555 Claim 1 are both drawn to
the same invention, "A viewer unit". These claims differ in scope in that Application
Claim 47 is broader in scope than Patent 6,240,555 Claim 1. Therefore, it would have
been obvious to one of ordinary skill in the art at the time the invention was made to
modify Patent 6,240,555 Claim 1 by omitting some limitations so to obtain Application
Claim 47.

Allowance of Application **Claim 47** would result in an unjustified time-wise
extension of the monopoly granted for the invention defined by Claim 1 of Patent
6,240,555. Therefore, obviousness-type double patenting is appropriate.

Application **Claim 48** with the additional limitations, "a visual display"
and "the processor being programmed to compile a list of the interactive programs and
present the list of interactive programs on the visual display" corresponds to Patent

6,240,555 Claim 1, because it is inherent to have a display so as to be able to view the EPG.

Application **Claim 54** and Patent 6,240,555 Claim 1 are both drawn to the same invention, "A system having an (EPG)". These claims differ in scope in that Application **Claim 54** is broader in scope than Patent 6,240,555 Claim 1. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Patent 6,240,555 Claim 1 by omitting some limitations so to obtain Application **Claim 54**.

Allowance of Application **Claim 54** would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Patent 6,240,555 Claim 1. Therefore, obviousness-type double patenting is appropriate.

8.   Claims **49-53** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending Application (10/832,765).

Application **Claim 49** with additional limitations, i.e., ("a computer-readable medium comprising computer-executable instructions" and "compiling a list of interactive programs, wherein each interactive program in the list is a program having an associated target specification" and "presenting the list of interactive programs through an EPG user interface supported by the EPG") claims all limitations of Provisional Application 10/832,765 Claim 1.

Application **Claim 49** and Application 10/832,765 Claim 1 are both drawn to the same invention, i.e. "a storage medium that is used to organize programming information". Although the conflicting claims are not identical, they are not patentably distinct from each other because both Application **Claim 49** and Claim 1 of Application 10/832,765 are almost the same in scope, although Claim 1 of Application 10/832,765 omits some limitations in Application **Claim 49**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Claim 1 of Application 10/832,765 with those additional limitations so to obtain Application **Claim 49** as claimed.

Allowance of Application **Claim 49** would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Claim 1 of Application 10/832,765. Therefore obviousness-type double patenting is appropriate.

Application **Claim 50** corresponds to Application 10/832,765 Claim 1 with the additional limitation "entering a target specification into the supplemental content field comprises receiving the target specification from a provider selected from either a supplemental content provider and a viewer accessing the EPG UI".

Application **Claim 51** corresponds to Application 10/832,765 Claim 1 with the additional limitation "receiving multiple target specifications for a program; and prioritizing the multiple target specifications according to viewer preferences".

Application **Claim 52** corresponds to Application 10/832,765 Claim 1 with the additional limitation "the compiling comprises searching the EPG for interactive programs".

Application **Claim 53** corresponds to Application 10/832,765 Claim 1 with the additional limitation "the target specification is selected from the group comprising: a memory pointer, a hyperlink, and a universal resource locator".

If Applicant agrees that a provisional obviousness type double patenting exists between Application 10/620,254 and Co-pending Application 10/832,765, and an obviousness type double patenting between Application 10/620,254 and Patents 6,631,523, 6,025,837 and 6,240,555. The Examiner then requests Applicant to provide a terminal disclaimer for each of the above Provisional/Obviousness-type double patenting rejections, along with a terminal disclaimer between Co-pending Application 10/832,765 and Patents 6,631,523, 6,025,837, and 6,240,555; and a terminal disclaimer between Patents 6,631,523, 6,025,837 and 6,240,555.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9.   Claims 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Knee (US Patent 5,589,892).

For **Claim 49** Knee teaches:

A computer-readable medium comprising computer-executable instructions (Fig. 1 Elem. 21 in view of Col. 10 Lines 56-70, note Elem. 21 is the memory location for the EPG application software) configured for:

designating data fields in an electronic programming guide (EPG) to hold programming information (Fig. 18, Note the program titles within the cells, Elem. 185 for example; and Col. 11 Lines 31-39);

dedicating one of the data fields as a supplemental content field (Fig. 20 Elem. 203 with Col. 11 Lines 31-39; and Col. 20 Lines 3-11); and

entering a target specification into the supplemental content field to correlate supplemental content with a program, the target specification identifying a location for the supplemental content (Fig. 20 Elem. 203 and Fig. 21, Note the system displays an "i" icon to correlate additional program information for the user, and as described in Col. 20 Lines 3-11 when the "i" icon is selected the system displays the appropriate information [Fig. 21]; hence that particular icon referenced a particular program description);

compiling a list of interactive programs (Col. 33 Lines 1-4 and 17-23), wherein each interactive program in the list is a program having an associated target specification (Fig. 51 Elem. 530, note the "i" icons displayed for each program signifying an interactive program; see Col. 20 Lines 3-13); and

presenting the list of interactive programs through an EPG user interface (UI) supported by the EPG (Fig. 51).

For **Claim 50** as discussed in independent Claim 49 Knee further teaches:

A computer-readable medium as recited in claim 49, wherein the entering a target specification into the supplemental content field comprises receiving the target specification from a supplemental content provider (Col. 20 Lines 3-11 with Col. 46 Lines 1-7).

For **Claim 51** as discussed in Claim 50 Knee further teaches:

A computer-readable medium as recited in claim 50, further comprising computer-executable instructions configured for:

receiving multiple target specifications for a program (Fig. 43A Elem. 401 and the "i" icon, note the star icon references a screen [Fig. 44] which displays items to purchase related to a particular program); and

prioritizing the multiple target specifications according to viewer preferences (Knee Col. 43 Lines 7-11, note Knee teaches screens may be configured according to user preferences).

For **Claim 52** as discussed in Claim 49 Knee further teaches:

A computer-readable medium as recited in claim 49, wherein the compiling comprises searching the EPG for interactive programs (Note providing a list of interactive programs [Knee Fig. 51] entails searching the EPG records for interactive programs; see also [Knee Col. 34 Lines 20-27]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims **47-48, 53-54** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Knee (U.S. Patent 5,589,892) in view of Throckmorton (U.S. Patent 5,818,441).

For **Claim 47** Knee teaches:

A user interface unit (Figure 1 and Column 9 Lines 50-54) comprising:

a processor (Fig. 1 Element 16);

an electronic programming guide (EPG) executing on the processor (Col.

11 Lines 32-46) to organize programming information (Col. 19 Lines 14-19),

including correlating additional information with particular programs in the EPG

(Fig 20 Elem. 203, Col. 20 Lines 3-12, and Col. 46 Lines 1-8, and Col. 47 Lines

19-21);and

the processor being programmed to search the EPG and identify the

particular programs having correlated information as an interactive program (Col.

34 Lines 12-34).

While Knee suggests that supplemental information can be derived from the

Internet (Col. 46 Lines 4-7), Knee does not expressly teach:

Correlating *Internet universal resource locators (URLs)* with particular

programs in the EPG, *the URLs identifying target resources that contain*

supplemental information related to the particular programs

the processor being programmed to search the EPG and identify the

particular programs having *correlated URLs* as interactive programs.

Throckmorton teaches:

URLs identify target resources that contain supplemental information

related to the particular programs (Col. 9 Lines 1-8)

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to incorporate the URL's which reference web pages

as taught by Throckmorton as the link to additional information about a particular

program taught by Knee.

The motivation would have been to allow a viewer to access additional

information about a particular program, which is available on the Internet in a

convenient manner (Throckmorton Col. 1 Lines 51-54).

For **Claim 48** as discussed in independent Claim 47 Knee further teaches:

A user interface unit as recited in claim 47, further comprising a visual

Display (Fig. 1 Elem. 27, and Col. 9 Lines 49-58) the processor being

programmed to compile a list of the interactive programs and present the list of

interactive programs on the visual display (Fig. 51 Elem. 530, note the "i" icons

displayed for each program signify an interactive program; see Col. 20 Lines

3-13).

For **Claim 53** as discussed in independent Claim 49,

Knee does not expressly teach:

A computer-readable medium as recited in claim 49, wherein the target

specification is a universal resource locator.

Throckmorton teaches:

A computer-readable medium as recited in claim 49, wherein the target

specification is a universal resource locator (Throckmorton, Col. 9

Lines 1-8).

Therefore, it would have been obvious to one having ordinary skill in the

art at the time the invention was made to incorporate a URL as taught by Throckmorton

as the target specification in the EPG system taught by Knee.

The motivation would have been to allow a user to access additional information

about a particular program which is available on the internet in a convenient manner

Throckmorton (Col. 1 Lines 51-54).

For **Claim 54** Knee teaches:

In a system having an electronic programming guide (Figure 1, and

Column 9 Lines 50-54), a method

comprising:

correlating additional information with corresponding programming

information in the EPG (Fig 20 Elem. 203, Col. 20 Lines 3-12, and Col. 46 Lines

1-8, and Col. 47 Lines 19-21); and

, searching the EPG to identify interactive programs within the programming

information that have correlated information (Col. 34 Lines 12-34).

Knee does not teach:

correlating *hyperlinks* with corresponding programming information in

the EPG; and

searching the EPG to identify interactive programs within the programming

information that have correlated *hyperlinks*

Throckmorton teaches:

Hyperlinks as a reference to associated data (Col. 9 Lines 1-14).

Therefore, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to incorporate the hyperlinks which reference web

pages as taught by Throckmorton as the link to additional information about a particular
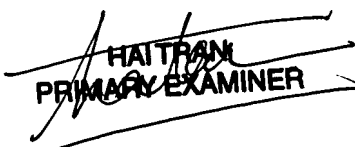
program taught by Knee.

The motivation would have been to allow a viewer to access additional

information about a particular program, which is available on the Internet in a

convenient manner (Throckmorton Col. 1 Lines 51-54).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward C. Sipple IV whose telephone number is 571 270 3414. The examiner can normally be reached on M-F 7:30-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached at 571 272 7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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PRIMARY EXAMINER